

REMARKS/ARGUMENTS

Favorable reconsideration of this application as presently amended and in light of the following discussion is respectfully requested.

Claims 31, 33-35, 37-39, 41, 43, 44, 46-48, 50-52, 54, 56, 57, 59, 61, 62, and 64 are pending in the present application. No new matter has been added.

By way of summary, the Official Action presents the following issues: Claims 31, 33-35, 37-39, 41, 43, 44, 46-48, 50-52, 54, 56, 57, 59, 61, 62, and 64 stand rejected under 35 U.S.C. § 103 as being unpatentable over Katinsky et al. (U.S. Patent 6,452,609, hereinafter Katinsky) and in view of Venkatesh et al. (U.S. Patent 5,974,503, hereinafter Venkatesh).

Rejection Under 35 U.S.C. § 103

The Official Action has rejected Claims 31, 33-35, 37-39, 41, 43, 44, 46-48, 50-52, 54, 56, 57, 59, 61, 62, and 64 under 35 U.S.C. § 103 as being unpatentable over Katinsky in view of Venkatesh. The Official Action contends that Katinsky describes all of the Applicant's claimed features with the exception of a display which shows content being placed at the end of a respective playlist when its playback is terminated. However, the Official Action cited Venkatesh as describing this more detailed aspect of the Applicant's claimed advancement and states that it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the cited references for arriving at the Applicant's claims. Applicant respectfully traverses the rejection.

Applicant's Claim 31 recites, *inter alia*, a playback apparatus for reproducing contents by sequentially switching the contents in accordance with a first and second playlist which identify the contents that are recorded, the playback apparatus including:

... switching means for switching between the arrangements of the displays of the first and second play lists

showing the contents in response to the switching of the playback of the contents, ...

Katinsky describes a media access web page (10) generated by an internet site for the purpose of accessing multimedia streams. The page includes four functional areas, including a media icon access panel (12), a sequencer (14), an object player (16), and a site-driven area (18).<sup>1</sup> As shown in Figure 4, the sequencer (14) includes a playlist box (44), a playlist button (46) and control buttons (48) by dragging media icons from the media icon access panel (12) into the sequencer (14) the user creates a sequence of playlist (50).<sup>2</sup> As shown in more detail in Figure 6A, the user can manage an organized playlist through the use of the menu system embodied by playlist button (44). In this manner when a user clicks on the playlist button (46) a pop-up menu (70) appears with four options: create, delete, rename, and Go To. The Go To option switches to a different stored playlist.

Conversely, in an exemplary embodiment of the Applicant's claimed advancement, a playback apparatus is provided for playing back contents by sequentially switching the contents in accordance with a first and second playlist. A display is provided to show the contents in the first and second playlists. A display produces contents in the first and second playlists in an arrangement so that the contents are continuous in sequence in a playback sequence from a content that is currently played back at least from one of a display of an operation element for instructing a starting of playback and a display of an operation element for instructing a stopping of playback. The apparatus switches between the arrangement of the displays of the first and second playlists showing the contents in response to the switching of the playback of the contents. A display showing content whose playback is terminated is placed at an end of an arrangement of the contents forming the first or second playlist from which it was played.

<sup>1</sup> Katinsky at Figure 1; column 4, lines 7-10.

<sup>2</sup> Katinsky at column 4, line 66 through column 5, line 4.

As discussed above, Applicant notes that the aspects of the Katinsky reference which are relied upon to allegedly disclose the Applicant's switching features is identified at column 5, lines 40-41.<sup>3</sup> In this respect, Applicant respectfully submits that the manipulation of menu tabs by a user for selecting one of a plurality of stored playlists is not a switching between a first and second playlist in response to the switching of the playback of contents as recited in Applicant's Claim 31.

As apparent from the above identified distinction, the required analysis of the base Claim 1 recited "switching means" and associated functions has not been performed. In this regard, the PTO reviewing court recently emphasized that conclusory findings that omit analysis as to "means" claim limitations are improper in Gechter v. Davidson 43 USPQ2d 1030, 1035 (Fed. Cir. 1997) as follows:

In addition, the [PTO] never construed the scope of the structures disclosed in the specification for the claimed "receiving means," nor did the [PTO] expressly find that the "receiving means" disclosed in the specification was structurally equivalent to that embodied in [the reference]. Moreover, the [PTO] also failed to define the exact function of the receiving means, as well as to find that [the reference] disclosed the identical function. [Emphasis added, citation omitted.]

Thus, it appears that the outstanding Action is relying on conjecture or unfounded assumptions in suggesting that Katinsky describes a switching means in accordance with the identical function recited in the Applicants' claims, which, recites "...switching between arrangements of the displays of the first and second play lists showing the contents in response to the switching of the playback of contents." However, this is clearly a modification of the actual teachings found at col. 5 lines 40-41 and such a modification to actual reference teachings using unfounded assumptions and/or speculation is improper. See *In re Warner*, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967) ("The Patent Office

<sup>3</sup> See Official Action of July 13, 2006 at paragraph 3.

has the initial duty of supplying the factual basis for its rejection. It may not, because it may doubt that the invention is patentable, resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in its factual basis.”).

There is no PTO analysis as to how this completely dissimilar user actuated menu system “means,” can be said to be structurally equivalent to the Claim 1 switching means. Likewise, there is no PTO analysis as to the required explanation of how the Katinsky functions disclosed at the relied upon section col. 5 lines 40-41 are **identical to the functions claimed** as to the switching means, as the above noted *Gechter* decision requires.

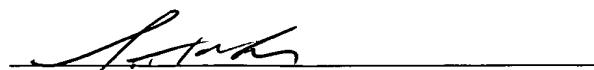
Accordingly Applicant respectfully requests that the rejection of Claims 31, 33-35, 37-39, 41, 43, 44, 46-48, 50-52, 54, 56, 57, 59, 61, 62, and 64 under 35 U.S.C. § 103 be withdrawn.

#### Conclusion

Consequently, in view of the foregoing amendment and remarks, it is respectfully submitted that the present application, including Claims 31, 33-35, 37-39, 41, 43, 44, 46-48, 50-52, 54, 56, 57, 59, 61, 62, and 64, is patentably distinguished over the prior art, in condition for allowance, and such action is respectfully requested at an early date.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,  
MAIER & NEUSTADT, P.C.



Bradley D. Lytle  
Attorney of Record  
Registration No. 40,073  
Scott A. McKeown  
Registration No. 42,866

Customer Number  
**22850**

Tel: (703) 413-3000  
Fax: (703) 413 -2220  
(OSMMN 03/06)